

REMARKS

Claims 1-16 are pending. The Applicant respectfully submits no new material is presented herein.

Allowed/Allowable Claims

The Applicant respectfully acknowledges and appreciates the indication by the Examiner that Claims 11-16 are allowed and the indication that Claims 6, although objected to for being dependent upon a rejected base claim, *i.e.*, Claim 1, would be in condition for allowance if rewritten in independent form, including all of the features of the base claim and any intervening claims.

The Specification

The Specification is objected to for a typographical error in the paragraph bridging pages 7-8. Applicant has amended the paragraph bridging pages 7-8 of the Specification to be responsive to the objection. Withdrawal of the objection is respectfully requested.

Claims Rejected—35 U.S.C. § 112

Claims 1-5 are rejected under 35 U.S.C. § 112, first paragraph as not enabling any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with the claims. Specifically, the Office Action asserts Claims 1-5 are rejected because the Specification, while being enabling for providing capability for simultaneous rotation of a heel support about the heel-toe axis of the of the patient's foot and also traverse movement with respect to that axis by employing a tilt lever arm 32, does not reasonably provide enablement for this simultaneous movement by other means. Applicant respectfully traverses the rejection.

35 U.S.C. § 112, first paragraph, requires that the Specification describe how to make and use the invention recited by the claim in question. See M.P.E.P. § 2164. The test for enablement requires a determination of whether the originally filed disclosure contains sufficient information regarding the subject matter of the claim as to enable one of ordinary skill in the art to make and use the claimed invention. See M.P.E.P. § 2164.01. The Applicant notes, and the Office Action admits, the Specification is enabling with regards to providing the capability for simultaneous rotation of a heel support about the heel-toe axis of the patient's foot and also transverse movement with respect to that axis by employing the tilt lever arm 32. However, the Office Action asserts the Specification is not enabling as a whole, because the specification does not disclose other means capable of producing the same simultaneous movement as provided by the tilt lever arm 32. Applicant respectfully submits the Office Action fails to cite any statutory provision or regulation to support this assertion. In particular, the Applicant respectfully submits the Office Action fails to provide any support for the assertion that 35 U.S.C. § 112, sixth paragraph "means plus function" features of a claim must be supported by multiple, *i.e.*, at least two, examples of structural features to satisfy the 35 U.S.C. § 112, first paragraph enablement requirement. Further, Applicant respectfully notes M.P.E.P. § 2164.02 provides that only an enabling disclosure is required and that an Applicant is not required to describe all actual embodiments. Additionally, the presence of only one working example should never be the sole reason for rejecting a claim as being broader than an enabling disclosure.

Therefore, because the Office Action admits that the tilt lever arm 32 described in the specification is enabling so as to provide the simultaneous rotation of a heel support

about the heel-toe axis of the patient's foot and also transverse movement with respect to that axis and because the Applicant is not required to describe all actual embodiments capable of performing the same simultaneous movement, the Applicant respectfully submits the rejection is improper. Accordingly, the Applicant respectfully requests withdrawal of the rejection.

Claims Rejected—35 U.S.C. § 102(b)

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 5,979,067 to Waters (hereinafter "Waters '067"). Applicant respectfully traverses the rejection.

Claim 1 discloses an apparatus to correctly align a foot to permit an orthotic device to be fabricated including a heel support and a front foot rest positioned substantially level therewith and in front of the heel support to define a heel-toe axis in front of the heel support and the heel support being mounted on a heel adjustment means arranged to simultaneously pivot the heel support about the heel-toe axis and move the heel support transverse to the heel-toe axis.

Waters discloses a device and related method for measuring foot posture, wherein the device includes a first half and a second half 10 and 10', respectively, both being identical except for a connection assembly 70. The first half and second half 10 and 10' each include a frame 20 and a split-surface platform 50. Each split-surface platform 50 includes a rear plate 51, and a front plate 52. The rear plate 51 is pivotably connected to the base 20 via thru-bolts 81 and 82 located a distance below the rear plate 51. The rear plate 51 is made to pivot about an axis passing through the thru-bolts 81 and 82 by rotating a rear adjustment knob 32. Similarly, the front plate 52 is

pivotably connected to the base 20 via thru-bolts 81 and 83 located a distance below the front plate 52. The front plate 52 is made to pivot about an axis passing through the thru-bolts 81 and 83 by rotating a rear adjustment knob 42. Because thru-bolts 81, 82, and 83 are coaxial, the axis about which the rear plate 51 pivots and the axis about which the front plate 52 pivots are coincidental.

A patient's foot is placed on the split-surface platform 50 such that the heel of the foot is resting on the rear plate or heel support 51 and the forward portion of the foot, including the toes of the foot, is resting on the front plate 52. The patient's foot defines a heel-toe axis that passes through both the heel and toes of the foot. Because the patient's foot is placed on an upper surface of the split-surface platform 50, the heel-toe axis is located above the split-surface platform 50. Hence, when a user adjusts the rear adjustment knob 32, the rear plate or heel support 51 pivots about the axis defined by the thru-bolts 81, 82, and 83 and not the heel-toe axis, which is located above the split-surface platform 50. Therefore, Applicant respectfully submits that Waters '067 does not teach or suggest a heel support being mounted on a heel adjustment means arranged to simultaneously pivot the heel support about the heel-toe axis and move the heel support transverse to the heel-toe axis as disclosed in Claim 1 of the present invention.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See M.P.E.P. § 2131. As explained above, Waters '067 does not teach or suggest each and every feature recited by Claim 1. In particular, Applicant respectfully submits Waters '067 specifically teaches the rear plate or heel support 51 pivots about an axis defined

by thru-bolts 81, 82 and not the heel-toe axis. Accordingly, Applicant respectfully submits Claim 1 is not anticipated by, or rendered obvious in view of, Waters '067 and should be deemed allowable.

Claims 2 and 4 depend from Claim 1. It is respectfully submitted that these dependent claims be deemed allowable for the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein.

Therefore, the Applicant respectfully requests withdrawal of the rejection.

Claims Rejected—35 U.S.C. § 103(a)

Claims 3 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Waters '067 in view of Official Notice that providing stirrups is known for preventing unwanted movement of a foot during evaluation of a foot's physical condition and also in view of U.S. Patent No. 4,747,989 to Peterson (hereinafter "Peterson '989"). Applicant respectfully traverses the rejection.

Claims 3 and 5 depend from Claim 1.

Peterson '989 discloses a method and apparatus for making corrected custom foot molds. Peterson '989 discloses a molding platform including a base 15, a knee stabilizer apparatus 18 for positioning a patient's knee, and specially-contoured cushions 34 and 35 to conform to the shape of a patient's feet. Peterson '989 does not teach or suggest a heel support and a front foot rest positioned substantially level therewith and in front of the heel support to define a heel-toe axis in front of the heel support or a heel support being mounted on a heel adjustment means arranged to simultaneously pivot the heel support about the heel-toe axis and move the heel support transverse to the heel-toe axis as disclosed in Claim 1 of the present invention. Put

simply, Peterson '989 does not overcome or otherwise address the above-described deficiencies of Waters '067.

The Office Action takes Official Notice that providing stirrups is known for preventing unwanted movement of a foot during evaluation of a foot's physical condition, or, in other words, the use of stirrups as described above is capable of such instant and unquestionable demonstration as to defy dispute. However, the Office Action does not offer a single reference in support of this assertion. The Applicant respectfully submits that the use of stirrups to prevent unwanted movement of a foot during evaluation of a foot's physical condition is not capable of instant and unquestionable demonstration as to defy dispute and respectfully requests the citation of some reference work recognized as standard in the pertinent art that supports the Office Action's assertion on this point.

To establish *prima facie* obviousness, each feature of the rejected claim must be taught or suggested by the prior art of record. See M.P.E.P. § 2143.03. Notice of facts beyond the record may only be taken when those facts are capable of instant and unquestionable demonstration as to defy dispute. See M.P.E.P. § 2144.03. It is improper to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. *Id.* Therefore, because both Waters '067 and Peterson '989 do not teach or suggest a heel support being mounted on a heel adjustment means arranged to simultaneously pivot the heel support about the heel-toe axis and move the heel support transverse to the heel-toe axis; and because providing stirrups to prevent unwanted movement of a foot during evaluation of a foot's physical condition is not a

fact capable of instant and unquestionable demonstration so as to defy dispute, the Applicant respectfully submits that the Office Action has failed to establish *prima facie* obviousness. As such, Applicant respectfully submits Claims 3 and 5 are not rendered obvious in view of Waters '067, Peterson '989, and the cited Official Notice; submits Claims 3 and 5 should be deemed allowable for at least the same reasons Claim 1 is allowable, as well as for the additional subject matter recited therein; and requests withdrawal of the rejection.

Conclusion

In view of the foregoing, reconsideration of the application, withdrawal of the outstanding objection and rejections, allowance of Claims 1-16, and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 026328-00006**.

Respectfully submitted,
ARENT FOX PLLC



Murat Ozgu
Attorney for Applicant
Registration No. 44,275

Customer No. 004372

1050 Connecticut Avenue, NW, Suite 400
Washington, DC 20036-5339
Telephone: (202) 857-6000

GEO:MO:DR